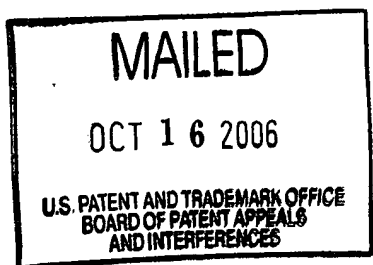


UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MOHAMMAD SARWAR NASIR  
and  
MICHAEL E. JOLLEY

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Application 09/905,452

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on October 10, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Examiner's Answer was mailed May 3, 2006.

Section § 1207.02 of the Manual of Patent Examining Procedure (MPEP) (8<sup>th</sup> Ed., Rev. 3, August 2005) states:

### Requirements for Examiner's Answer

The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

....

(2) *Related Appeals and Interferences*. A statement acknowledging appellant's identification of related cases which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal . . . .

....

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

The Examiner's Answer is deficient because it does not contain a statement regarding the "Related Appeals and Interferences."

In addition, it is also noted that while the Examiner's Answer lists the "Declaration of Mohammad S. Nasir Pursuant to 37 C.F.R. 132" and Pestka et al, "Immunological Assays for Mycotoxin Detection", Food Technology, February 1995, pp. 120-128, on page 2 under the caption "(8) Evidence Relied Upon", the claim rejections are listed as follows:

Claims 1-4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable [over] Dixon et al (USP#4,835,100) in view of

Nasir et al (Combinatorial Chemistry High Throughput Screening, 1999, 2, 177-190) [page 3];

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dixon in view of Nasir et al., and further in view of and further in view of [sic] Michel et al (USP#5,741,654) [page 4];

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dixon et al in view of Nasir et al and further in view of McMahon et al (USP#5,166,078) [page 5]; and

Claims 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nasir et al in view of Dixon et al. [page 6];

The Examiner's Answer is deficient because it does not include Dixon et al., Nasir et al (Combinatorial Chemistry & High Throughput Screening) article, Michael et al. and McMahon et al. Correction is required.

Finally, an Information Disclosure Statement (IDS) was filed on August 22, 2005. It is not apparent from the record whether the examiner considered the statement submitted or notified appellants regarding why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying appellants of the Primary Examiner's decision is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for submission of a revised Examiner's Answer which includes the "Related Appeals and Interferences" section and corrects the "Evidence Relied Upon" section;
- 2) for consideration of the IDS filed August 22, 2005, and written notification to appellants regarding the Primary Examiner's decision; and
- 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: G. P. Edgell for Dale Shaw  
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